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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,482	12/08/2003	Bruce Steinberg	062365.00006	2564

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EXAMINER
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MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/730,482

Applicant(s)

STEINBERG, BRUCE

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____                                                            | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed September 7, 2005. The Examiner acknowledges the amendments to the specification and to claims 1, 3 and 6. Claims 1-6 are pending.

#### ***Terminal Disclaimer***

2. The terminal disclaimer filed on September 7, 2005 presumed to disclaim the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,659,967 has been reviewed and is NOT accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The application/patent being disclaimed has not been identified.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Leonard et al. ('044). Leonard et al. teach a method for a user to evaluate muscles of a limb that may be suspected of compartment syndrome. The method includes applying increasing pressure to the limb being evaluated over a predetermined time period with the distal end of an applicator instrument (20)

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including a force plate (23) and a force probe (68); monitoring the predetermined time period by way of a concluding signal that is detectable by the user; sensing and measuring the pressure applied to the force probe; storing a series of pressure measurements over the predetermined time period; sensing and measuring the distance between the force plate and force probe; storing a series of distance measurements over the predetermined time period; monitoring the force rate of application of the device; and modifying the rate of application of force based upon the monitoring. The force probe may be considered to have a solid cross section and an area substantially smaller than the cross section of the force plate, when said cross section of the force probe is taken at the proximal-most or distal-most ends of the probe or when element (62) is considered the force probe.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 3-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,659,967. Although the conflicting claims are not identical, they are not patentably distinct from each other because

the claims of the patent and the claims of the instant application are directed to substantially equivalent inventions or obvious variations thereof.

Regarding claim 1 of the instant application, the claim is merely broader than claim 1 of the patent. Both claim 1 of the patent and claim 1 of the instant application recite an applicator instrument including a base portion; a force plate; a force probe that is slidably positioned through an aperture in the force plate, where the force plate and the force probe are biased relative to one another; at least one stabilizing column slidably received in the base portion; an encoder; and a load cell. The cross section of the probe has an area that inherently is smaller than the cross sectional area of the force plate, since the force probe must be inserted through an aperture in the force plate. Claim 1 of the patent recites additional elements not recited in claim 1 of the instant application. Since claim 1 of the patent “anticipates” the broader claim 1 of the instant application, the claims are not patentably distinct.

Regarding claim 3 of the instant application, the claim is merely broader than claims 1 and 2 of the patent. Claims 1 and 2 of the patent and claim 3 of the instant application all recite an applicator instrument including a force plate; a force probe that is slidably positioned through an aperture in the force plate; a spring that biases the force probe relative to the force plate; an encoder; and a load cell. The cross section of the probe has an area that inherently is smaller than the cross sectional area of the force plate, since the force probe must be inserted through an aperture in the force plate. Claim 1 of the patent recites additional elements not recited in claim 3 of the instant application. Since claims 1 and 2 of the patent “anticipates” the broader claim 3 of the instant application, the claims are not patentably distinct. Claims 3 and 4 of the patent correspond to claims 4 and 5 of the instant application, respectively.

***Allowable Subject Matter***

7. Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,659,967 in view of Mocny ('469). U.S. Patent No. 6,659,967, as discussed above, teaches all of the limitations of the claim except that the device includes a series of lights for providing a user feedback regarding the force application of the instrument. Mocny teaches a device including a force probe (2) and a series of lights (8) that provide a user with feedback regarding the force application of the instrument. It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide a device similar to that of U.S. Patent No. 6,659,967 with a series of lights similar to those of Mocny in order to provide a user with feedback regarding the force application of the instrument.

***Response to Arguments***

8. Applicant's arguments, see pages 6-7 of the Remarks, filed September 7, 2005, with respect to the objection to the specification; the rejection of claims 1 and 3 under 35 U.S.C. 102(b) as being anticipated by Imoto ('312); and the rejection of claim 2 as being unpatentable over Imoto ('312) in view of Mocny ('469) have been fully considered and are persuasive. The objection to the specification; the rejection of claims 1 and 3 under 35 U.S.C. 102(b) as being anticipated by Imoto ('312); and the rejection of claim 2 as being unpatentable over Imoto ('312) in view of Mocny ('469) have been withdrawn.

9. Applicant's remaining arguments filed September 7, 2005 have been fully considered but they are not persuasive.

Applicant contends at page 6 of the Remarks that a new Information Disclosure Statement was to be submitted with the Amendment in order to overcome the Examiner's objections; however, no such IDS has been received by the Office at the time of this Office Action.

At page 7 of the Remarks, Applicant contends that Leonard ('044) fails to teach that the force probe has a solid cross section and an area that is substantially smaller than the cross section of the force plate, as required by claim 6 as amended, and that such a construction is preferred because it minimizes the pain encountered in applying the instrument. The Examiner respectfully submits that the claim fails to define where the claimed cross section of the probe is taken, and how the applicator/force probe construction relates to the claimed method steps to minimize the pain encountered. Therefore, although the bulk of the cap (68) of Leonard is hollow with a spring (66) disposed therein, a cross section taken at the proximal-most or distal-most ends of the force probe cap (68) may be considered to meet the structural limitations of the claimed applicator. Alternatively, element (62) of Leonard may be considered the force probe, to meet the structural limitations of the claim. In view of the foregoing, the rejection of claim 6 under 35 U.S.C. 102(b) as anticipated by Leonard has been maintained.

Finally, at page 8 of the Remarks, Applicant contends that the terminal disclaimer submitted with the Amendment is sufficient to overcome the rejection of claims 1 and 3-5 under the judicially created doctrine of obviousness-type double patenting. This argument is not persuasive because the terminal disclaimer was disapproved for reasons cited above.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

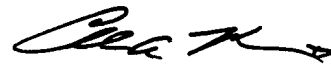
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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November 16, 2005